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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,163	12/20/2001	Jeffrey Coutts	PF02257NA	1209
20280	7590	02/10/2005	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			BAYARD, DJENANE M	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,163

Applicant(s)

COUTS ET AL.

Examiner

Djenane M Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/31/03, 12/20/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 8, 11-13, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,584,494 to Manabe et al.

a. As per claim 1, Manabe et al teaches a communication support system and method for promoting smooth communication in a chat system. Furthermore, Manabe et al teaches a method for a data network system for responding to a communication message with a canned reply by a target user of a target device, the method comprising the steps of: receiving a communication message from an originating device (See col. 4, lines 31-32 and col. 6, lines 35-41, the detection means detects the sending of any text information from a first communication device on the network); retrieving configuration data of the target device; determining whether the target device is available for interactive communication with the originating device based on the configuration data (See col. 4, lines 32-39 and col. 6, lines 46-50, the acquisition means detects whether a second communication device correlated with the detected text information is operating and acquires from the second communication device the user status); routing the communication message to the target device if the target device is available for interactive

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communication with the originating device (See col. 8, lines 62-65 and figure 7); and sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 7, lines 42-65).

b. As per claim 2, Manabe et al teaches the claimed invention as described above.

Furthermore, Manabe et al teaches wherein the interactive communication is conducted in real-time between an originating user of the originating device and the target user of the target device (See col. 6, lines 63-67)

c. As per claim 3, Manabe et al teaches the claimed invention as described above.

Furthermore, Manabe et al teaches wherein the step of determining includes the step of detecting whether an instant messaging application of the target device is active (See col. 7, lines 8-20).

d. As per claim 4, Manabe et al teaches the claimed invention as described above.

Furthermore, Manabe et al teaches configuring the canned reply by the target device before the step of receiving the communication message from the originating device (See col. 7, lines 43-45).

e. As per claim 11, Manabe et al teaches a data network system for responding to a communication message with a canned reply by a target user of a target device, the data network system comprising: a messaging server for communicating with a plurality of client devices, the messaging server being effective to route the communication message from an originating device

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to the target device (See col. 6, lines 23-26 and figure 1); and a messaging proxy coupled to the messaging server, the messaging proxy being effective to direct the messaging server to route the communication message to the target device if the target device is available for interactive communication with the originating device and to send the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device (See col. 3, lines 45-60).

f. As per claims 6 and 16, Manabe et al teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for configuration of the originating device exist (See col. 7, lines 1-7).

g. As per claims 8 and 18, Manabe et al teaches the claimed invention as described above. Furthermore, Manabe et al teaches determining whether rules for configuration of the target device exist (See col. 9, lines 55-64).

h. As per claim 12, Manabe et al teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the messaging proxy is incorporated within the messaging server (See col. 4, lines 24-29).

i. As per claim 13, Manabe et al teaches the claimed invention as described above. Furthermore, Manabe et al teaches wherein the target device includes an instant messaging application that is active (See col. 7, lines 25-40).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 7, 9, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,430, 604 to Ogle et al.

a. As per claims 5 and 15, Manabe et al teaches the claimed invention as described above. However, Manabe et al failed to teach wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device.

Ogle et al teaches a technique for enabling messaging systems to use alternative message delivery mechanism. Furthermore, Ogle et al teaches wherein if the test has a negative result then the message can not be sent (See col. 11, lines 4-14).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the step of sending the canned reply to the originating device includes the step of withholding the communication message from the target device as taught by Ogle et al in the claimed invention of Manabe et al in order to enable messages to be sent from

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instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

b. As per claims 7 and 17, Manabe et al teaches the claimed invention as described above. However, Manabe et al failed to teach the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices.

Ogle et al teaches the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices (See col. 8, lines 30-55).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the steps of routing a first canned reply to the originating device if the target device is in at least one classification of devices, and routing a second canned reply to the originating device if the target device is outside of the at least one classification of devices as taught by Ogle et al in the claimed invention of Manabe et al in view of Ogle in order to order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

c. As per claims 9 and 19, Manabe et al teaches the claimed invention as described above. However, Manabe et al failed to teach the steps of routing a first canned reply to the originating

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device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area.

Ogle et al teaches the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area (See col. 3, lines 36-49).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the steps of routing a first canned reply to the originating device if a location of the target device is within a defined area, and routing a second canned reply to the originating device if the location of the target device is outside of the defined area as taught by Ogle in the claimed invention of Manabe et al in order to enable messages to be sent from instant messaging system to users who are reachable through alternative delivery mechanism (See col. 2, lines 46-48).

5. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent No. 6,301,609 to Aravamudan et al.

a. As per claims 10 and 20, Manabe et al teaches the claimed invention as described above. However, Manabe et al failed to teach the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status

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information against the configuration data to determine whether the target device is available for interactive communication.

Aravamudan et al teaches an assignable associate priorities for user-definable instant messaging buddy groups. Furthermore, Aravamudan et al teaches the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication (See col. 7, lines 20-65).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the step of retrieving status information of at least one of the originating device and the target device, wherein the step of determining whether the target device is available for interactive communication includes the step of comparing the status information against the configuration data to determine whether the target device is available for interactive communication as taught by Aravamudan et al in the claimed invention of Manabe et al in order to provide features and capabilities associated with existing and emerging Instant messaging services and communication protocols to locate a registered user, query the user for a proposed message disposition or other action (See col. 2, lines 25-30).

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,584,494 to Manabe et al in view of U.S. Patent Application No. 2004/0048615 to Kato et al

a. As per claim 14, Manabe et al teaches the claimed invention as described above.

However, Manabe et al failed to teach a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device.

Kato et al teaches a mobile packet communication system. Furthermore, Kato et al teaches a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device (See page 5, paragraph [0095]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a location register coupled to at least one of either the messaging server and the messaging proxy, the location register being effective to generate a current location of the target device as taught by Kato et al in the claimed invention of Manabe et al in order to store for each mobile terminal address the current location of the corresponding mobile terminal 9See page 5, paragraph [0095]).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Application No. 2003/0191808 to Adler et al teaches a communications system with radio device and server.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (571) 272-3878.

The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER